

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIANG C. DONG,
MICHAEL H. DEALEY, TERRY L. BURKOTH,
PATRICK S. L. WONG, JERRY D. CHILDERS
and BRIAN L. BARCLAY

Appeal No. 95-0815
Application 07/963,967¹

ON BRIEF

Before JOHN D. SMITH, PAK and WARREN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 11, 13 through 15 and 41 through 43, all of the claims in the application.²

We have carefully considered the record before us, and based thereon, find that we cannot sustain the examiner's rejection of all of the appealed claims under 35 U.S.C § 103 over Theeuwes et

¹ Application for patent filed October 21, 1992. According to appellants, this application is a division of application 07/804,137, filed December 6, 1991, now U.S. Patent 5,200,195, issued April 6, 1993.

al.³ and of appealed claim 13 under 35 U.S.C § 103 over Theeuwes et al. as previously applied further in view of American Hospital Formulary Services, as set forth in the answer (Paper No. 18, pages 3-4). It is well settled that the examiner may satisfy his burden of establishing a *prima facie* case of obviousness under § 103 by showing some objective teachings or suggestions in the prior art taken as a whole or that knowledge generally available to one of ordinary skill in the art would have led that person to arrive at the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988); *In re Warner*, 379 F.2d 1011, 1014-17, 154 USPQ 173, 176-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). We cannot conclude that the examiner has carried her burden in the case before us.

We agree with appellants (main brief, Paper No. 14, page 3) that Theeuwes et al. does not teach a dosage form containing a drug composition which comprises at least a steroid, a hydrophilic polymer possessing a critical solution temperature of 35° to 50°C, and a polyhydroxy compound that exhibits an affinity for water as required in the method of appealed claim 11. Theeuwes et al. disclose a dosage form which contains two separate compositions, i.e., a drug composition ("first component 16;" e.g. col. 4, lines 14-31, and col. 6, line 23, to col. 7, line 5) and a push composition ("second component 17;" e.g., col. 4, lines 32-56, and col. 7, lines 66), in similar manner to the dosage form of appealed claim 11. However, the drug composition as taught in the reference does not contain the hydrophilic polymer and the polyhydroxy compound specified in the appealed claims. Indeed, this is apparent from the examiner's reliance on portions of the reference disclosure which pertain to the push composition to find these components, and in fact, the portion of appellants' specification relied on by the examiner for a description of the hydrophilic polymer is directed to the push composition found in the appealed claims (answer, page 3). We further note that Theeuwes et al. (col. 8, lines 31-50) separately prepare and compress the drug and push compositions and the examiner has not set forth

² Amendment of May 28, 1993 (Paper No. 4, pages 2-3).

³ The references relied on by the examiner are listed at page 2 of the answer. We refer to these references in our opinion by the name associated therewith by the examiner.

any scientific reasoning why the ingredients in these compositions would be expected to mix *in situ* and still function as taught in the reference.

Accordingly, the record before us supports the inference that the examiner has relied on information gleaned from appellants' disclosure in formulating the grounds of rejection on appeal. *Dow Chemical, supra; Warner, supra.*

The examiner's decision is reversed.

Reversed

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
CHARLES F. WARREN)	
Administrative Patent Judge)	

Appeal No. 95-0815
Application 07/963,967

Paul L. Sabatine
Alza Corporation
P.O. Box. 10950
Palo Alto, CA 94303-0802